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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional)	
<p>I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]</p> <p>on <u>May 22, 2006</u> (filed via facsimile)</p> <p>Signature <u><i>John R. Harris</i></u></p> <p>Typed or printed name <u>John R. Harris</u></p>		Application Number	Filed
		09/923,213	August 6, 2001
		First Named Inventor	
		Wheeler et al.	
		Art Unit	Examiner
		2137	Kevin Schubert
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/98)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. 30,388 Registration number _____</p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.</p> <p><input type="checkbox"/> *Total of _____ forms are submitted.</p>			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Patent

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**RECEIVED
CENTRAL FAX CENTER****MAY 22 2006**

Inventors: Wheeler, et al. **Examiner:** Kevin R. Schubert
Application No. 09/923,213 **Group Art Unit:** 2137
Filed: August 6, 2001 **Docket No.:** 10399-34384
Confirmation No.: 8986

Title: MANUFACTURING UNIQUE DEVICES THAT GENERATE DIGITAL SIGNATURES

CERTIFICATE UNDER 37 CFR 1.8:

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filed via facsimile at 571 272 8300 or filed via EFS-Web, on this May 22, 2006

By: 

Name: John R. Harris

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
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Sir:

The United States Patent and Trademark Office issued a final office action dated February 21, 2006, which rejected all of the pending claims. Concurrently with a Notice of Appeal, Applicant hereby requests that a panel of examiners formally review the legal and factual basis of the examiner's rejections prior to the filing of an appeal brief and pursuant to the United States Patent and Trademark Office's Pre-Appeal Brief Conference Pilot Program, as extended on January 10, 2006 (1303 OG 21). Applicant respectfully requests favorable reconsideration in view of the comments below.

In an office action dated September 5, 2005, the examiner rejected claims 1-5 on grounds of nonstatutory double patenting and on other grounds. Claim 1 was rejected under 35 U.S.C. § 102(b) as being anticipated by *Fischer* (5,422,953). Claims 2-5 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Fischer* in view of *Spies* (6,230,269). Please refer to the arguments of record in response to that office action in the paper filed February 7, 2006, wherein applicant amended Claim 1 to address the §102(a) rejection, cancelled claims 6-20, and added

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dependent claims 21–31. A Terminal Disclaimer was offered with respect to the nonstatutory double patenting rejection (the offer is hereby renewed and maintained).

In the most recent office action of February 21, 2006 (“Office Action”), the double patenting rejection was maintained, and a §112 rejection was made. (The issues of this rejection can readily be addressed via a supplemental amendment.) More significantly, the rejection of claim 1 under §102(b) as anticipated by *Fischer* was maintained (as well as claims 4–5, 21, and 25), the rejection of claims 2–3 over *Fischer* in view of *Spies* was maintained, and a new rejection of various dependent claims under §103(a) based on *Fischer* in view of a patent to *Ramasubramani et al.* (6,233,577), and publications by *Scheneier* and/or *Menezes*.

For the reasons which follow, it should be apparent that the *Fischer* patent, as directed to a “notary device” that teaches nothing about manufacturing methods, does not anticipate claim 1, and that *Spies* and *Ramasubramani* only teach subsidiary concepts that as a whole do not render the rejected dependent claims obvious.

Claim Rejections 35 USC § 102(b) – Claim 1 was rejected under 35 U.S.C. § 102(b) as being anticipated by *Fischer*. (See the Office Action, pp. 4–5, for the examiner’s characterization of that reference). *Fischer* describes a personal date/time notary device (e.g., smart card, token, etc.), which is a secure device that digitally signs messages that include a date/time stamp. The private key is maintained within the device, which defines its own secure, tamper-resistant environment, to deter unauthorized access to, taking of, or tampering with the private key and the internal date/time clock. This patent says nothing about the disposition of the public key other than that the manufacturer generates a certificate to indicate that the public key is authorized for use with this particular notary device (col. 5, lines 64–67). Trust and authenticity of the device, the private key, and the internal date/time clock is determined and reliably identified solely based upon one or more digital certificates that accompany a digital signature and time/date stamp originated by such devices. See FIG. 3, components 61, 62, of *Fischer* and related discussion. Such digital certificates include a single manufacturer’s certificate 61 attesting to the fact that the device is trusted (see col. 5, lines 59–68) and that the time-date stamp is accurate.

Where in *Fischer* is anything corresponding to a database in a secure environment in which other information is stored in association with the public key? Where in *Fischer* is any

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teaching of methods for manufacturing devices that generate digital signatures? And where is manufacturing in a secure environment? And where is any teaching that each device may be reliably and uniquely identified by any means other than a certificate? Such teachings, it is submitted, are simply not present.

In the Office Action, the examiner indicated that *Fischer* provides for creating a public-private key pair “within a secured [sic] environment” and “securely linking the public key with other information within the secure environment.” This simply and factually incorrect. There is nothing in *Fischer* that could possibly be considered a “database within the secure environment” for storing the public key in association with the other information. The “secure environment” in *Fischer*, following the examiner’s reasoning, can only be the device itself—but there is clearly no database in the *Fischer* device itself for storing the public key in association with other information! The examiner’s application of *Fischer* in rejecting claim 1 is simply factually inadequate.

For this reason alone, claim 1 is not anticipated, as *Fischer* fails to disclose, teach or suggest any storage of a public key in association with other information in a database in a secure environment associated with manufacturing of the device, and it is submitted that an appeal on this issue should not be necessary.

The examiner’s cited excerpt from *Fischer* (“certificates may be [sic, are] stored externally to the device (e.g., in storage associated with a computer driving the notary device) or internally ...”)(Office Action, page 11, line 9) does not factually support the statement that *Fischer* discloses “storing the public key in association with other information in a database.” Again, it is certificates that are stored in *Fischer*, not merely the public key, and not in conjunction with manufacturing devices such that each device may be reliably and uniquely identified.

Thus, the examiner’s reliance upon *Fischer* as anticipating a claim for manufacturing a digital signature device within a “secure environment” cannot be factually justified. The claimed method is for manufacturing devices that generate digital signatures such that each device may be reliably and uniquely identified, the devices being manufactured within a secure environment. Such a secure “manufacturing” environment cannot be the a “secure environment” defined by a device itself, as suggested by the examiner’s reliance on *Fischer*, because a device itself cannot

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define a manufacturing environment in which it itself is created. That makes no sense. Accordingly, it is respectfully submitted that claim 1, as amended, is not anticipated by *Fischer*, and it is requested that the rejection be withdrawn without further requiring an appeal.

Claim Rejections 35 USC § 103 – Claims 2–5 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Fischer* in view of *Spies*, U.S. Patent No. 6,230,269. The examiner asserted that, as per claim 2, the applicant describes the method of claim 1, which is met by *Fischer*, with the following limitation which is met by *Spies*: Wherein each private-public key pair is created within each device based on a random number produced by a random number generator disposed within each device (*Spies*, claim 16).

Claims 2 and 3 are a dependent claims and add further limitations. Applicant is not claiming the use of a random number or random number generator by itself for use in connection with the claimed method, but rather that the private key/public key pair is created within the device and based on a random number produced by a random number generator, together with the method of manufacturing steps of claim 1. For this reason alone claims 2 and 3 should be patentable. Furthermore, under the doctrine of *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988), if an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious. No further comments are believed necessary, but applicant reserves the right to argue separate patentability on appeal.

In the most recent office action, the examiner rejected claims 22–24 and 27–28 as unpatentable over *Fischer* in view of *Ramasubramani*. This patent was cited as teaching that the PuK-linked information stored in the database includes the identity of a plurality of third parties with which an account is maintained, the accounts being identified by one of a plurality of third party account identifiers (cited to FIG. 4B). The examiner indicated that *Ramasubramani* discloses the idea that certificates are stored and maintained for a plurality of third parties in a centralized database, the accounts being identified by one of a plurality of third party account identifiers.

The examiner's citation of *Fischer* in view of *Ramasubramani* for a 35 U.S.C. 103(a) rejection of these claims is therefore factually erroneous given the fact that both references teach a technically and conceptually different system than the system taught by the claims of the present invention. *Fischer* and *Ramasubramani* both teach certificate authority digital signature

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(CADS) systems as opposed to an account authority digital signature (AADS) system that underlies the claims of this application. None of the references cited by the examiner anticipate, teach, or disclose systems or methods of manufacturing devices that generate digital signatures such that each device may be reliably and uniquely identified without the need of a digital certificate. Those references do not teach anything about the manufacturing process for a digital signature device. It is therefore factually, and legally, improper for the examiner to base a rejection of the present claims on patents that describe systems that are so conceptually different from, and teach away from, the present invention.

Furthermore, under the doctrine of *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988), if an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious. No further comments are believed necessary, but applicant reserves the right to argue separate patentability on appeal.

Finally, the examiner rejected claim 26 over *Fischer* in view of *Schneier*, and claims 29-31 over *Fischer* view of *Menezes*. These are dependent claims that add further limitations and should be allowable under the rationale of *In re Fine*, supra. Space does not permit a full explanation of why these references, combined with *Fischer*, do not render these dependent claims obvious. Accordingly, no further comments can be made at this time, but applicant reserves the right to argue separate patentability on appeal.

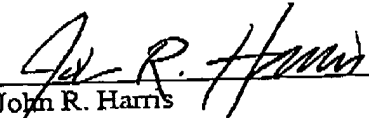
In view of the foregoing remarks, Applicant submits that the claims stand in condition for allowance, and Applicant respectfully requests the passing of the present application to issue without requiring further prosecution of an appeal.

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Respectfully submitted,

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